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Remarks

Claims 1-17, 19, 20, 23-29 and 31 are pending in this application. By this paper, Applicants have amended claims 2, 5-6, 10-12, 16-17, 20, 23, 25-27, 29 and 31. Please cancel claim 28.

The present invention relates to a sliding visor and is the subject of reissue examination as discussed herein.

Reissue Applications

Applicants are not aware of any prior or concurrent proceedings in which Patent No. 6,010,174 is or was involved, other than this reissue application no. 10/037,280. These proceedings would include interferences, reissues, reexaminations, and litigation. Applicants acknowledge and appreciate the Examiner's reminders of this continuing obligation and that set forth in 37 C.F.R. § 1.56 to timely apprise the office of any information which is material to patentability of the claims under consideration in this reissue application.

Oath/Declaration

Applicants acknowledge and appreciate the withdrawal of the rejection due to the newly filed declaration of February 24, 2003.

Claim Rejections 35 U.S.C. § 112

Claim 2 has been amended to eliminate the vague expression "vertical". Rather than using the terms "vertical" and "horizontal," the term "perpendicularly" has been added to clarify the spacial relationship.

Claim 11 has been amended so that a ridge extends from said wall, not the reverse.

Claim 10 has been amended to remove “are adapted to”, as the term “adapted” has been rejected as being vague.

Claim 20 has been amended to refer to “the guide” rather than “a guide”.

Claim 28 has been canceled by this paper.

Accordingly, Applicants respectfully assert that claims 2, 10-11, and 20 have been amended to overcome the rejections under 35 U.S.C. § 112.

Recapture

Claims 5-17, 19-20, 23-29, 31 have been rejected by the Examiner under 35 U.S.C. § 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. However, the claims have been amended by this paper, thus narrowing the scope to subject matter that was not surrendered in the application for the issued patent.

“Under [the recapture] rule, claims that are ‘broader than the original patent claims in a manner directly pertinent to the subject matter surrendered during prosecution’ are impermissible.” *Hester Industries, Inc. v. Stein Inc.*, 142 F.3d 1472, 1480, 46 USPQ2d 1641 (Fed. Cir. 1998), quoting *In re Clement*, 131 F.3d 1464, 1468, 45 USPQ2d 1161, 1164 (Fed. Cir. 1997); quoting *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 996, 27 USPQ2d 1521, 1525 (Fed. Cir. 1993). “Application of the recapture rule begins with a determination of whether and in what respect the reissue claims are broader than the original patent claims.” *Id.* 142 F.3d at 1480. “Reissue claims that are broader in certain respects and narrow in others

may avoid the effect of the recapture rule.” *Id.* 142 F.3d at 1482, 46 USPQ2d 1641, quoting *Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165. *Clement* set forth the test:

“(1) if the reissue claim is as broad or broader than the cancelled or amended claim in all aspects, the recapture rule bars the claim; (2) if it is narrower in all aspects, the recapture rule does not apply, but other rejections are possible; (3) if the reissue claim is broader in some aspects, but narrower in others, then: (a) if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim; (b) if the reissue claim is narrower in an aspect germane to prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible.”

131 F.3d at 1470.

Independent claims 5, 9, 16, 29 and 31 are all narrower in aspects germane to the prior art rejection, by the guide including a pair of opposing legs.

The reissue claims now presented do not impermissibly recapture surrendered subject matter.

“If the limitation now being omitted or broadened in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application, the omitted limitation relates to subject matter previously surrendered by applicant, and impermissible recapture exists.”

MPEP § 1412.02. Although the subject matter of original claim 1 was *cancelled*, “[t]o determine whether an applicant *surrendered* particular subject matter, we look to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection.” [Emphasis added] *Clement* 131 F.3d at 1469, 45 USPQ2d at 1164. Accordingly Applicants may present claims that are broader *vis-à-vis* the original claims by

omitting limitations from the original claims, even if the omitted subject matter was cancelled, as long as the omitted subject matter was not surrendered.

With reference now to claim 5, a marked up copy as amended by this paper is attached below.

5. (Currently Amended) A sliding sun visor assembly comprising:
a rod assembly including:
a longitudinally extending rod;
a torque control pivotally attached to said rod [having a first pivotal attachment to said rod], and a guide fixed to one surface of said torque control, the guide having a pair of opposing legs defining a longitudinal slot therebetween; and
a visor body including:
a structure projecting therefrom defining a longitudinally extending bore for receiving said rod [that at least partially circumscribes said rod and defines a second pivotal attachment to said rod, wherein at least one of said pivotal attachments is slidably engaged to said rod], and
a longitudinally extending track being shaped to receive a portion of said guide, wherein the track cooperates longitudinally between [cooperate within] the pair of opposing legs of said guide in a sliding engagement within the slot, whereby upon moving the visor body longitudinally along said rod, said track slides relative to said guide [allowing said visor body to move longitudinally with respect to the rod].

Support for this change is provided in Figures 2, 3, 6 and 7 in the accompanying text beginning at column 2, line 49.

The Examiner has indicated that claim 5 was rejected for broadening the subject matter of claim 1 of the patent by leaving out claimed details. Final Office Action, page 4, lines 5-7. Accordingly, claim 5 has been amended by this paper to include the subject matter of original claim 1 except for “said track forming a substantially enclosed longitudinally extending passage adjacent one surface of said visor body.”

Claim 5 is a reissue claim that is broader in scope in some aspects but narrower in others *vis-à-vis* claims canceled from the original application to obtain a patent. Claim 5 avoids the effect of the recapture rule because claim 5 is broader in a way that does not attempt to reclaim what was surrendered earlier. *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 994, 27 USPQ2d 1521, 1525 (Fed. Cir. 1993). Claim 5 is narrower with respect to the guide by including the pair of opposing legs and the longitudinal slot - an aspect germane to the prior art rejection. Claim 5 is also narrower with respect to the track than original claim 1 because “the track cooperates longitudinally between the pair of opposing legs of said guide in a sliding engagement within the slot.”

Claim 5 is broader by omitting the longitudinally extending passage limitation of original claim 1. The passage limitation of original claim 1 was not relied upon to distinguish over the prior art in the prosecution of the patent, nor were arguments made that the passage limitation distinguished the original claims over the prior art. This feature was in the canceled claim, but not surrendered. Accordingly, Applicants should not be estopped from broadening and narrowing the claimed subject matter of the track, because the passage limitation of the track was not relied upon for reasons of patentability. Unlike *Pannu v. Storz Instruments, Inc.*, 258 F.3d 1366, 1372 (Fed. Cir. 2001), wherein “the reissued claims were not narrowed in any material respect compared with their broadening,” amended claim 5 is narrowed materially in comparison to its broadening. The narrowing limitations to the track are directly related to the broadening aspects of the track of claim 5; therefore *Pannu* does not apply, and amended claim 5 overcomes the recapture rejection.

Claims 6-15 depend from claim 5 and therefore overcome the recapture rejection for at least the reasons stated above with reference to claim 5. Dependant claim 6 has been amended in light of the changes to claim 5 to maintain proper antecedent basis to dependent claim 6. Support for this change may be found in Figures 2, 6 and 7 and the accompanying text beginning at column 4, line 1. Claim 12 has also been amended as illustrated below.

12. (Currently amended) The visor of claim [10] 5, wherein said track forms a substantially enclosed longitudinally extending passage adjacent one surface of said visor body, and said visor is assembled by sliding the opposing legs of said guide onto said track from an opening to the passage provided on a distal end of said track.

Claim 12 has been amended to depend from claim 5 rather than claim 10 and further includes the limitation of the longitudinally extending passage. Support for this change is provided in Figures 2, 3, 6 and 7 and the accompanying text beginning at column 3, line 57. Accordingly, claim 12 includes all of the canceled subject matter of original claim 1 and thus is not broader than original claim and avoids the recapture rule.

Referring now to claim 16, claim 16 has been amended as follows:

16. (Currently Amended) A sliding sun visor comprising:

a rod assembly including a longitudinally extending rod[;], a torque control [component having a first pivotal attachment to the rod;] pivotally attached to said rod, and a guide fixed to one surface of said torque control, the guide having a pair of laterally spaced opposing legs; and

a visor body [having a second pivotal attachment with the rod] including a longitudinally extending bore for receiving said rod, the [second pivotal attachment] bore being substantially coaxial with the [first pivotal attachment] rod, and the visor body including a longitudinally extending track, one of said track and said pair of opposing legs of said guide forming a substantially enclosed longitudinally extending passage adjacent one surface of said visor body, said passage being shaped to receive a portion of the other of said track and said pair of opposing legs of said guide in a sliding engagement; whereby upon moving the visor body longitudinally along said rod, said track slides relative to said guide

[wherein at least one of said pivotal attachments is slidably engaged with said rod allowing longitudinal movement of at least a portion of the visor body with respect to said rod; and

a longitudinally extending track interconnecting the opposing legs of the guide and the visor body in sliding

engagement parallel to the longitudinal rod such that the torque control maintains a rotational position of the torque control with respect to the rod, and consequently maintains rotational positions of the track, the visor body and the second pivotal attachment with respect to the rod, said track allowing a longitudinal distance between the first and second pivotal attachments to vary with longitudinal movement of said visor body].

Claim 16 has been amended to include all of the elements of original claim 1. Claim 16 is narrower than the claims canceled or amended in the original application with regards to the guide - an aspect germane to the prior art rejection. Specifically, the guide of claim 16 requires "a pair of opposing legs." Claim 16 has been amended to include the longitudinally extending passage, however it is broadened wherein the passage is formed by one of the track and the pair of opposing legs, rather than being formed by the track as originally claimed. The passage has also been narrowed because the passage is either formed by the pair of opposing legs or receives a portion of the pair of opposing legs.

Although the passage has been included in claim 16 and is both broader and narrower than the passage as originally claimed, the broadening is not limited by recapture because the passage limitation was not argued to overcome the prior art. Accordingly, under *Pannu*, Applicants are not estopped by prosecution history from this broadening. Additionally, Applicants' narrowing of the passage, which requires it to be formed in the pair of opposing legs or receiving a portion thereof, is material to the broadening of the passage.

Claims 19-20 and 23-27 depend from claim 16 and therefore overcome the recapture rejection for at least the reasons stated above with reference to claim 16. Claim 18 has been canceled by this paper. Claim 17 has been amended as illustrated below to maintain proper antecedent basis in light of the changes to claim 16.

17. (Currently Amended) The visor of claim 16, wherein said [second pivotal attachment] bore is slidably engaged with the rod, and said [first pivotal attachment] torque control is non-slidably engaged with the rod.

Claim 23 has been amended to depend from claim 16 rather than claim 20. Claim 25 has been amended to depend from claim 16 rather than claim 20 as well. Claim 25 has been further amended to include "said track forms said passage." Support for this change is provided in Figures 2, 3, 6 and 7 and the accompanying text beginning at column 3, line 57. Claim 25, unlike claim 16, is not broad relative to the original independent claim 1 by requiring that the passage is formed by the track, and therefore claim 25 includes all of the canceled subject matter of original claim 1 and avoids the recapture rule.

Claims 26 and 27 are amended by this paper as illustrated below to maintain proper antecedent basis with respect to claim 16 in light of the changes made to claim 16 by this paper.

26. (Currently Amended) The visor of claim 16, wherein a portion of said visor body proximate to said [second pivotal attachment] longitudinally extending bore limits a longitudinal range of movement of said visor body along said rod by contacting the torque control [component].

27. (Currently Amended) The visor of claim 26, wherein the portion of said visor body proximate to said [second pivotal attachment] longitudinally extending bore includes a projection to assist in limiting said longitudinal range of movement of said visor body along said rod by contacting the torque control [component].

Claim 29 has been amended by this paper as illustrated below:

29. (Currently Amended) A sliding sun visor comprising:
a rod assembly including a longitudinally extending rod[;], a torque control [having a first pivotal attachment to the rod] pivotally attached to said rod, said first pivotal attachment being substantially coaxial with said longitudinal rod[;], and a guide fixed to and extending from one surface of said torque control, said guide including a pair of opposing legs extending therefrom defining a longitudinal slot

therebetween; and

a visor body [having a second pivotal attachment slidably engaged with] including a longitudinally extending bore for receiving said rod allowing said visor body to slide axially with respect to said rod, said [second pivotal attachment projecting from said visor body and] longitudinally extending bore being substantially coaxial with said rod; said visor body also including a longitudinally extending track slidably engaged between said opposing legs of said guide and received within said longitudinal slot, said track [allowing a longitudinal distance between said first and second pivotal attachments to vary with movement of said visor body while maintaining a rotational position of said second pivotal attachment with respect to the rod substantially equal to a rotational position of said first pivotal attachment with respect to the rod] forming a substantially enclosed longitudinally extending passage adjacent one surface of said visor body, said passage being shaped to receive a portion of said guide in a sliding engagement; whereby upon moving the visor body longitudinally along said rod, said track slides relative to said guide.

Claim 29 includes all of the claim limitations of original claim 1 and therefore is not improperly broadened and recapture does not exist under the *Clement* test.

Claim 31 has been amended by this paper and is included below:

31. (Currently Amended) A sun visor assembly comprising:

a rod assembly including a longitudinally extending rod [including] having an elbow formed therein[;], a [first member] torque control pivotally attached to said rod in a non-slidable manner, and a guide fixed to one surface of said torque control and including a pair of opposing legs extending therefrom; and

a [sliding member with a pivotal attachment to] visor body including a longitudinally extending bore for receiving said rod, said [pivotal attachment] bore slidable along said rod between said [first member] torque control and said elbow, [said sliding member including a rail to cooperate in sliding engagement with said opposing legs of said first member to maintain a consistent rotational position of both said first member and said sliding member with respect to said rod] and

a longitudinally extending track, said pair of opposing legs of said guide forming a substantially enclosed longitudinally extending passage adjacent one surface of said visor body, said passage being shaped to receive a portion of said track in a sliding engagement; whereby upon moving the visor body longitudinally along said rod, said track slides relative to said guide.

Claim 31 has been amended by this paper to include all of the claim elements of original claim 1. However, claim 31 is broader than the original claim 1 because the longitudinally extending passage is formed by the pair of opposing legs rather than by the track. However, this is not impermissible broadening under *Pannu* because the track was not included nor argued to overcome the prior art in the prosecution history of the issued patent. Further, the passage is narrow with regards to the original claim 1 because the passage is formed in the pair of opposing legs and receives a portion of the track.

Applicants respectfully request that the Examiner's rejection under 35 U.S.C. § 251 of reissued claims 5-17, 19-20, 23-27, 28 and 31 be withdrawn for the reasons listed above.

Claim Rejections - 35 U.S.C. § 102

The Examiner has rejected claims 5-7, 13, 14-16, 19-20, 23-24, 26-29 under 35 U.S.C. § 102(b) as being anticipated by Clark.

Claim 5, as amended, requires "a pair of opposing legs defining a longitudinal slot therebetween... wherein the track cooperates longitudinally between the pair of opposing legs of said guide in a sliding engagement within the slot." The Examiner indicates that track 72, 74 cooperates with legs 58 at apertures 59 of Clark. However, the legs of Clark do not define a longitudinal slot therebetween and the track does not cooperate within the slot, rather passes through apertures 59 formed through the legs. Accordingly, claim 5 does not read on Clark and therefore is not anticipated thereby.

Claims 6-7, 13 and 14-15 depend from claim 5 and therefore are not anticipated by Clark for at least the reasons stated above with reference to claim 5.

Claim 16, as amended, requires “a pair of laterally spaced opposing legs.” In contrast, Clark includes a pair of longitudinally spaced legs. Further, claim 16 requires “one of said track and said pair of opposing legs of said guide forming a substantially enclosed longitudinally extending passage...to receive a portion of the other of said track and said pair of opposing legs.” The track referred to by the Examiner, guide rods 72, 74, does not include such a passage. The pair of legs 58 of Clark do not include such a passage either, rather each include a pair of apertures 59 for receiving the associated guide rods. The apertures are not longitudinally extending, rather are longitudinally spaced and have a longitudinal dimension defined by the thickness of the material of the associated leg (walls 58) and therefore do not satisfy the passage as claimed. Accordingly, claim 16 does not read on Clark and therefore is not anticipated thereby.

Claims 19-20, 23-24 and 26-27 depend from claim 16 and therefore are not anticipated by Clark for at least the reasons stated above with reference to claim 16. Further, claim 28 has been canceled by this paper.

Claim 29 as amended includes a pair of opposing legs “defining a longitudinal slot therebetween” and a track “forming a substantially enclosed longitudinally extending passage.” No slot and passage are found in the legs and track respectively of Clark. Accordingly, claim 29 does not read on Clark and therefore is not anticipated thereby.

In view of the foregoing, Applicants respectfully request that the Examiner withdraw all anticipation rejections.

Claim Rejections - 35 U.S.C. § 103

The Examiner has rejected claim 25 under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being obvious over Clark. Claim 25 is not anticipated by Clark for at least the reasons stated above with reference to claim 16. Further, claim 25 requires that "said track form said passage." The track indicated by the Examiner, guide rods 72, 74, do not form a substantially enclosed longitudinally extending passage and therefore claim 25 is not anticipated by Clark. Further, there is no motivation in Clark to provide the absent elements and assemble it as required in claim 25. Accordingly, Applicants assert that claim 25 is not obvious over Clark.

Applicants respectfully request that the Examiner withdraw the rejection to claim 25 under 35 U.S.C. § 102(b) or in the alternative under 35 U.S.C. § 103(a).

Allowable Subject Matter

Applicants appreciate the Examiner's indication that claims 1, 3, 4 are allowed. Applicants also appreciate the Examiner's indication that claim 2 would be allowed if rewritten to overcome the rejection under 35 U.S.C. § 112, second paragraph, and to include all of the limitations of the base claim and any intervening claims. Accordingly, claim 2 has been amended to overcome the rejection and includes all of the limitations of the base claim and any intervening claims. Therefore, claim 2 is amended as suggested by the Examiner.

Conclusion

Applicants respectfully assert that the application is in condition for allowance, which allowance is hereby requested.

Respectfully submitted,

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